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OFFICE OF PETITIONS

In re Application of :
Csore, et al. : DECISION ON APPLICATION
Application No. 09/823,814 : FOR PATENT TERM ADJUSTMENT
Filed: March 30, 2001 :
Atty. Dkt. No.: 4175 :
:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)", filed September 13, 2007.

The application for patent term adjustment (PTA) under 37 CFR 1.705(b) is **DISMISSED**.

The Determination of Patent Term Adjustment under 35 U.S.C. 154(b), mailed June 13, 2007, indicated a patent term adjustment (PTA) to date of zero days. The instant application for PTA was timely filed September 13, 2007, at the time of submission of the issue fee payment.

The correct PTA at the time of the allowance is zero days, as indicated on the Determination of Patent Term Adjustment mailed June 13, 2007.

Applicants do not dispute the adjustments totaling 178 days that have, to date, been accorded for Office delay under 37 CFR 1.702(a)(1) and 1.702(a)(2).

Applicants dispute the reduction of five days accorded in connection with the amendment after final rejection, filed September 21, 2004.

Applicants further dispute the reduction of 103 days in connection with the response after non-final action, filed August 1, 2005.

Applicants do not contest the remaining reductions accorded at the time of allowance.

The adjustment of 178 was properly reduced five days in connection with the amendment after final rejection filed September 21, 2004 in response to the final rejection mailed

June 16, 2004. The reduction began September 17, 2004, the day after the date that is three months after the date that the final rejection was mailed, and ended September 21, 2004, the date the amendment after final rejection was received.

Applicants argue that the amendment after final rejection filed September 21, 2004 bore a certificate of mailing date of September 15, 2004.

In accordance with 37 CFR 1.703(f), the date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in the calculation of patent term adjustment. Instead, the date of receipt of a reply is used to calculate patent term adjustment. Therefore, the adjustment was properly reduced five days.

The adjustment of 178 days was further properly reduced 103 days in connection with the response after non-final action filed August 1, 2005. In accordance with 37 CFR 1.704(c)(7), the reduction began April 21, 2005, the day after the date that the reply having an omission was filed in response to the non-final Office dated December 15, 2004, and ended August 1, 2005, the date that the reply correcting the previous omission was filed.

Applicants contend that the requirement for information contained in the December 15, 2004 non-final Office action was cumulative under 37 CFR 1.98(c) and that any delay should not be charged to applicants.

Applicants' arguments have been considered, but are not persuasive. A requirement for information under 37 CFR 1.105 is an action issued as a result of the examination conducted pursuant to 35 U.S.C. 131. As such, a requirement for information is a notification under 35 U.S.C. 132. See, generally, MPEP 2731. Accordingly, the provisions of 37 CFR 1.704(c)(7) are applicable to the reply submitted August 1, 2005 and the adjustment was properly reduced 103 days.

Applicants further reference the Rule 312 amendment that was submitted September 13, 2007. Applicants are advised that the patent term adjustment indicated in the patent will include any additional patent term reductions that accrue after mailing of the Notice of Allowance.

The instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of

the filing date of the application. A decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term for Office failure to issue the patent within three years. See, 37 CFR 1.703(b).

Further, the patent term adjustment indicated in the patent will include any additional patent term accrued pursuant to §§ 1.702(a)(4) and 1.702(b).

Applicants are reminded that if an application is entitled to an adjustment under 35 USC 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 USC 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 USC 154(b)(1)(B) in determining whether periods of delay overlap under 35 USC 154(b)(2)(A).

Thus, any days of delay for Office issuance of the patent more than three years after the filing date of the application that overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See, 35 USC 154(b)(1)(B), 35 USC 154(b)(2)(A), and 37 CFR § 1.703(f). See, also, Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of 37 CFR 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Applicants are given **TWO (2) MONTHS** from the mail date of the instant decision to file a written request for reconsideration of the instant decision as it concerns dismissals of requests for reconsideration of reductions which accrued prior to the mailing of the Notice of Allowance (i.e., the reduction of five days and the reduction of 103 days). Extensions of time pursuant to 37 CFR 1.136 are not available.

Receipt is hereby acknowledged of the required patent term adjustment application fee of \$200.00.

This application is being forwarded to the Office of Patent Publications for further processing.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kery Fries

Kery Fries
Senior Patent Attorney
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy